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OFFICE OF PETITIONS

In re Application of :
Yuan-Chang Chin :
Application No. 10/729,979 : ON PETITION
Filed: 12/09/2003 :
Attorney Docket No. 251316-1710 :

This is a decision in reference to the "PETITION TO WITHDRAW
HOLDING OF ABANDONMENT" filed on 9 August, 2007.

The petition is **DISMISSED**.

This application became abandoned on 12 April, 2007, for failure to submit a timely response to the non-final Office action mailed on 11 January, 2007, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply were obtained in accordance with 37 CFR 1.136(a). Notice of Abandonment was mailed on 3 August, 2007.

Petitioner asserts that a timely reply was filed by EFS-Web on 4 April, 2007, and has included a copy of the Acknowledgement Receipt showing transmission of 10 pages of an amendment, a power of attorney, and a Rule 3.73 document by EFS on 4 April, 2007.

Petitioner's argument has been considered, but is not persuasive.

Pursuant to MPEP 711.04(b), the electronic file is the official record of the application. A review of the Image File Wrapper (IFW) file reveals that on 4 April, 2007, 10 pages of an amendment were filed. Upon review, however, the amendment references Application No. "10/901,284" and a different inventor's name, art unit, examiner's name, filing date, and invention title than that of the subject application.

Pursuant to 37 CFR 1.5(a), when a letter directed to the Patent and Trademark Office concerns a previously filed application for

a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application.

In this case, it appears that applicant inadvertently filed, on 4 April, 2007, an amendment intended to be filed in another application. However, the showing of record is that no amendment intended for the subject application was timely filed.

Although the USPTO attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do so.¹ Rather, it is the applicants who are ultimately responsible for filing proper documents.²

The USPTO EFS-Web Legal Framework states that "[o]ne advantage of filing an application via EFS-Web is that applicant may view the submission in PAIR." As such, applicants could have reviewed the amendment after filing and rectified the error by timely filing the correct document.

Furthermore, the "Acknowledgment Receipt" supplied by the EFS-Web electronic filing system that is of record in the IFW of 10/729,979 and has that application number affixed thereto (N417 paper dated 7/13/2007), is, as stated in the Legal Framework that supports EFS-Web, merely equivalent to a postcard receipt under MPEP 503. The Legal Framework also provides that:

"If the official version of any document received by the EFS-Web is lost, damaged or rendered unreadable by the USPTO and if it cannot be recovered from the stored files received by electronic submission, then the applicant/reexamination party will be promptly notified as indicated in the EFS-Web instructions. In that situation, the applicant/reexamination party may have to resubmit the document(s) or portion of the document that are lost and petition for the original filing date. Such events are expected to be rare, indeed since inception of the EFS project no document submitted using USPTO EFS software and received in EFS has been lost. In most cases a phone call to the Electronic Business Center (EBC) will resolve the issue. But if

¹ See In re Colombo Inc., 33 USPQ2d 1530, 1532. (Comm'r Pat. 1994).

² Id.

that is not sufficient, the applicant/reexamination party would present (1) the Acknowledgement Receipt, (2) a copy of the missing files as submitted and (3) a signed petition and statement verifying that the attached files are the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt and statement will serve as *prima facie* evidence that the resubmitted documents are the same as those submitted on the date of receipt. Note the Acknowledgement Receipt only indicates that the USPTO received what was actually sent, as opposed to what may have been intended to be transmitted. Applicants/ reexamination parties should exercise the same care in preparing and preserving a copy of a submission in electronic form as in paper." (Emphasis added.)

Indeed, no document appears to have been lost. The record of 10/901,284 now contains two copies of the amendment in question, i.e., an amendment that is in the record of the proceeding and a duplicate of the same amendment that has been marked "closed." Both amendments were directed to application number 10/901,284. The record of 10/279,979 contains only the amendment that was copied into 10/901,284: i.e., the duplicate and now closed paper. Further, MPEP 502 provides that "[T]he USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Here, it is clear that the N417 paper in question is facially erroneous, since the record for both applications clearly does not contain any item directed to application number 10/729,979. Thus, it appears that the paper filed in 10/729,979 in response to the 1/11/2007 Office action was not a *bona fide* attempt to respond to that Office action. Accordingly, the period for filing a response to the outstanding Office action continued to run from the date upon which the Office action was mailed.³

In summary, the showing of record is that this error occurred as a result of a mistake on the part of petitioner, not the USPTO. While it is unfortunate that applicants did not file the correct amendment, the showing of record is that no amendment intended for the subject application was filed on 4 April, 2007. As

³ See 37 CFR 1.135(c) and MPEP 710.01.

petitioners have not provided sufficient evidence that an amendment directed to this application was timely filed, the application was properly held abandoned.

Petitioners may wish to consider filing a petition to revive the application, accompanied by a proper reply.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision. **This period may not be extended.**⁴

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
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By FAX: (571) 273-8300
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Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



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⁴ 37 CFR 1.181(f).